

U.S. Patent Application No. 10/593,914
Attorney Docket No. 10191/4329
Reply to Office Action of July 31, 2008

AMENDMENTS TO THE DRAWINGS:

Please amend without prejudice the Drawings as follows:

Figure 2 is amended without prejudice to correct a clerical omission of the reference label "13". This amendment to Fig. 2 does not add new matter since the corresponding text describing Fig. 2 clearly refers to a reference label "13". A Replacement sheet for Figs. 1 and 2 accompany this response. Approval and entry are respectfully requested.

Attachment: one (1) Replacement Sheet for Figures 1 and 2.

REMARKS

Claim 10 is canceled without prejudice, claims 17 to 21 are added, and therefore claims 9 and 11 to 21 are now pending.

Reconsideration is respectfully requested based on the following.

As an initial matter, Figure 2 is corrected as to a clerical omission of the reference label "13". The amendment to Fig. 2 does not add new matter since the corresponding text describing Fig. 2 clearly indicates a reference label "13". A Replacement sheet for Figs. 1 and 2 accompany this response. Approval and entry are respectfully requested.

Claims 9, 11, 12, 14, and 15 were rejected under 35 U.S.C. § 102(b) as anticipated by German Patent Publication Number DE 102 29 020 (the "Anton" reference).

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Final Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the rejections may not be agreed, to facilitate matters, claim 9 has been rewritten to better clarify the claimed subject matter by providing for "a holder, including the magnetic field sensor, wherein the holder supports the magnetic field sensor in such a way that the magnetic field sensor is positioned into a zero line of a magnetic field of the magnet by a movement of the holder." Independent claim 9 has been rewritten herein without

prejudice to include the subject matter that was originally provided for in the now-canceled claim 10. Claim 9 as presented relates to a connection element configured for measuring force by a displacement between a magnet and a magnetic field sensor, and further provides that the *holder including the magnetic field sensor* and that the *holder has a spring element*. The Office Action refers to the abstract of the “Anton” reference as assertedly disclosing these features. In particular, the Office Action refers to the flexion bars (2, 3) of the “Anton” reference as assertedly disclosing the “spring element” as provided for in the context of claim 9 (originally in claim 10).

In fact, the “Anton” reference does not identically disclose (nor even suggest) the feature that “the holder has a spring element” as provided for in the context of claim 9. To the extent that the Office is asserting that flexion bars (2, 3) correspond to the feature of the “spring element”, the Abstract and Fig. 1 of the “Anton” reference make it plain that the magnetic sensor element (6) and the flexion bars (2, 3) are on separate parts of a force sensor. Accordingly, the “Anton” reference does not identically disclose (or even suggest) the features of a holder that includes a magnetic field sensor and has a spring element, as provided for in the context of claim 9, as presented.

Accordingly, claim 9, as presented, is allowable, as are its dependent claims 11, 12, and 14.

Independent claim 15, as presented, includes features like those of claim 9, as presented, and is therefore allowable for essentially the same reasons as claim 9, as presented.

Claims 13 and 16 were rejected under 35 U.S.C. § 103(a) as unpatentable over the “Anton” reference alone.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claims 13 and 16 respectively depend from claims 9 and 15, as presented, and are therefore allowable for essentially the same reasons as claims 9 and 15, as presented, as explained herein.

Withdrawal of the rejections of claims 9 and 11 to 16 is therefore respectfully requested.

New claims 17 to 21 do not add new matters and are supported by the application. New claims 17 and 18 depend from claim 9 and are therefore allowable for at least the same reasons as claim 9. New claim 19 includes features analogous to those of claim 9, as presented, and is therefore allowable for at least essentially the same reasons, as are its dependent claims 20 and 21.

In sum, all of pending claims 9 and 11 to 21 are allowable.

CONCLUSION

In view of the foregoing, claims 9 and 11 to 21 are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,
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Dated: 10/17/2008

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